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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 10/720,281 | 11/25/2003 | Takayuki Hattori | 2927-0163P | 4758 |

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| EXAMINER |
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JACKSON, MONIQUE R

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| ART UNIT | PAPER NUMBER |
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1794

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| NOTIFICATION DATE | DELIVERY MODE |
|-------------------|---------------|

05/05/2008

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

mailroom@bskb.com

| | | | |
|------------------------------|---------------------------------------|---------------------------------------|--|
| Office Action Summary | Application No. 10/720,281 | Applicant(s) HATTORI ET AL. | |
| | Examiner Monique R. Jackson | Art Unit 1794 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 February 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3 and 5-32 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3 and 5-32 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. The amendment filed 2/19/08 has been entered. Claims 1-3 and 5-32 are pending in the application. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action. The indication of allowable subject matter is withdrawn in view of the newly discovered reference(s) to Hattori et al. Rejections based on the newly cited reference(s) follow.

Claim Rejections - 35 USC § 112

2. Claim 29 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 29 recites a method of manufacturing a belt wherein the belt is the conductive member according to claim 21, hence the conductive composition of Claim 29 should be the same as the conductive composition of claim 21 or within the ranges disclosed in claim 21. However, Claim 29 utilizes a composition that would not result in the belt of claim 21 and therefore it is unclear what is meant to be encompassed by the claim.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 1-3, 5, 7-20, 27-28, and 31-32 are rejected under 35 U.S.C. 102(e) as being anticipated by Hattori et al (USPN 7,141,183.)

The applied reference has a common inventor/assignee with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention “by another,” or by an appropriate showing under 37 CFR 1.131.

Hattori et al teaches a conductive elastomer composition having rubber-like elasticity and flexibility and thermoplastic-resin-like moldability and realizing a high conductivity, specifically a volume resistivity in the range from 10^4 to 10^{11} Ω -cm, when measured as claimed, wherein the conductive elastomer composition is suitable for producing conductive belts and rollers for an image-forming apparatus, wherein the composition taught by Hattori et al comprises the same polymers and conductive salt in amounts that read upon the claimed invention (Abstract; Col. 2-Col. 8, Col. 11-12; Examples.) Specifically, Hattori et al teach that the conductive elastomer composition includes a thermoplastic elastomer composition (A) containing a compound (A1) composed of a thermoplastic resin and/or a thermoplastic elastomer, such as polyester elastomers as claimed (*continuous matrix phase*) and a compound (A2), composed of a crosslinkable rubber and/or a crosslinkable thermoplastic elastomer such as EPDM as claimed (*second discontinuous phase*), dispersed in the compound (A1) by dynamically crosslinking the compound (A2); and an ionic-conductive agent (B), containing a metal salt and a polyether-containing block copolymer resin as claimed, dispersed in the thermoplastic elastomer composition (A) (*first discontinuous phase*), wherein the salt is associated with the polyether-containing block copolymer and the conductive agent (B) is preferentially dispersed in the matrix A1 not A2; and also teach the use

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of acrylonitrile-butadiene rubber contained in the composition. Hattori et al also teach that a conductive member formed from the composition has a compression set less than 30% when measured as claimed and a Shore hardness of 10 to 50 (Col. 12, lines 45-52.) Hattori et al also teach that the composition is formed by kneading the components as claimed. With respect to the other physical properties and relationships claimed, the Examiner takes the position that the invention taught by Hattori et al, comprising the same materials in the same amounts, would inherently possess the same properties as claimed.

5. Applicant cannot rely upon the foreign priority papers to overcome this rejection because a translation of said papers has not been made of record in accordance with 37 CFR 1.55. See MPEP § 201.15.

Double Patenting

6. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the “right to exclude” granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

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7. Claims 1-3 and 5-32 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-18 of U.S. Patent No. 7,141,183. Although the conflicting claims are not identical, they are not patentably distinct from each other because it would have been obvious to one having ordinary skill in the art to combine dependent claim limitations and to recognize that the A2 and B components form discontinuous phases in the A1 matrix. It would also have been obvious to one skilled in the art to recognize that the conductive composition of the patent would provide the same properties as instantly claimed and to utilize routine experimentation to determine the optimum amount of each component and suitable conductive salt to provide the desired conductivity for a particular end use. Further, one having ordinary skill in the art would have been motivated to include a flame retardant additive wherein the claimed additive is an obvious species of flame retardant utilized in the art.

Response to Arguments

8. Applicant's arguments filed 2/19/08 have been considered but are not persuasive and/or moot in view of the new ground(s) of rejection. With respect to the 112 rejection of Claim 29, the Applicant argues that the weight percentage in claim 29 does not conflict with the weight percentages in claim 21 given that claim 21 relates to a conductive master batch or a thermoplastic composition. However, as stated above, Claim 29 specifically states that the conductive member formed is the conductive belt of claim 21 and hence the resulting conductive composition of claim 29 should correspond to the conductive composition of claim 21.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Monique R. Jackson whose telephone number is 571-272-1508. The examiner can normally be reached on Mondays-Thursdays, 10:00AM-5:00PM.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rena Dye can be reached on 571-272-3186. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Monique R Jackson/
Primary Examiner, Art Unit 1794
April 28, 2008